

Remarks

Reconsideration of this Patent Application is respectfully requested, particularly as herein amended.

The Office Action mailed June 12, 2009, rejects applicants' claims 11, 12, 19, 20 and 23 under 35 U.S.C. §103(a) as being unpatentable over a proposed combination of the previously cited patent to Chayes et al. (US 1,688,136) with a newly cited patent to Lustig (US 4,449,932). Claims 14, 15, 21 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the proposed combination of Chayes et al. and Lustig, in further combination with the previously cited patent to Euvrard (US 6,155,827). Such rejections of applicants' claims are respectfully traversed, and reconsideration and withdrawal of the presented rejections of claims is respectfully requested.

Before addressing the position stated in the Office Action, it has been noted that the Examiner has not considered certain elements of applicants' claims. However, noting Section 2143.03 of the Manual of Patent Examining Procedure, the Examiner is respectfully reminded that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art", citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Noting the bottom of page 6 through the top of page 7 of the Office Action, it appears that at least some elements of the claims have not been considered because such

elements are considered to constitute a "statement of intended use and other functional statements". However, noting Section 2173.05(g) of the Manual of Patent Examining Procedure, the Examiner is respectfully reminded that "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim...", citing *In re Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004). It is, therefore, respectfully requested that the reconsideration of applicants' claims which is currently being requested include a consideration of all of the elements recited in applicants' claims.

Turning now to the position stated in the Office Action of June 12, 2009, an enlargement of Fig. 2 of Chayes et al. is provided at the top of page 3, and various correlations between the structures shown in Fig. 2 of Chayes et al. and structures recited in applicants' claims are alleged on pages 3 and 4. It is respectfully submitted, however, that the alleged correlations are based on an incorrect reading of the disclosure of Chayes et al.

Noting lines 87 to 97 of page 1 of Chayes et al., the tool (unnumbered) used with the tool holding part 16 (which is said to constitute the "head" of Chayes et al.) is comprised of a "shaft or arbor 25" and a "grinding stone 27", and is said to be "placed in the bore of the chuck 21". Noting lines 71 to 84 of page 1 of Chayes et al., the "tool holding chuck or socket 21"

includes the "geared flange 20" which meshes with the "bevel pinion 19" of the driving shaft 18, and "the lower end" of the chuck 21 is "supported by the bearing member 23 which has a threaded engagement with an end of the bore 24 in which the chuck 21 is arranged" (emphasis added).

As a consequence, only the shaft 25 and the stone 27 (i.e., the tool) are capable of being inserted into or removed from the remainder of the illustrated apparatus, and the tool holding chuck 21 is secured within the bore 24 by the threaded engagement established between the bore 24 and the bearing member 23. As a consequence of this, however, the "handle" of the tool of Chayes et al. (i.e., the shaft 25) does not include "a first rotary drive which, when mounted in the housing, is capable of meshing directly with a second rotary drive associated with the body of the head... wherein the first rotary drive is capable of retractable axial retention in the housing, independently of the second rotary drive", in accordance with applicants' claim 11, and contrary to the position taken at the bottom of page 3 of the Office Action of June 12, 2009.

Moreover, as a further consequence of this, and as has been discussed in earlier submissions made in connection with this Patent Application, the shaft 25 of the tool of Chayes et al. is inserted into the tool holding chuck 21 through an opening (again unnumbered) provided in the tool holding chuck 21, which is in turn supported within the bore 24 of the apparatus by the

threaded bearing member 23. Noting lines 104 to 106 of page 1 of Chayes et al., the "latching device 30" which is used to lock the tool in the tool holding chuck 21 is located at the opposite end of the bore 24, and is arranged in a chamber which is fully enclosed (see, lines 25 to 29 of page 2) by a cover plate 35 which cooperates with the upper surface 33 of the part 38 (see, lines 7 to 11 of page 2). As a consequence, the unnumbered opening in the tool holding chuck 21 is the only "opening" provided for the insertion of a tool into the disclosed dental tool holder.

The enlargement of Fig. 2 of Chayes et al. which is provided at the top of page 3 of the Office Action of June 12, 2009, labels the bearing support 22 provided in the upper surface 33 of the part 38 as an "opening", presumably the "opening for insertion of the instrument into the housing" which is recited in applicants' claim 11. However, as has previously been demonstrated, the shaft 25 of the tool of Chayes et al. is inserted into the unnumbered opening of the tool holding chuck 21 associated with the threaded bearing member 23, and the opposite end of the bore 24 is fully enclosed by the cover plate 35. As a consequence, the shaft 25 of the tool cannot be inserted into the bore 24 through the bearing support 22 provided in the upper surface 33 of the part 38, and is not inserted into the bearing support 22 until after it exits from the tool holding chuck 21 and the bore 24.

It is, therefore, respectfully submitted that the bearing support 22 provided in the upper surface 33 of the part 38 is not "an opening for insertion of the instrument into the housing", in accordance with applicants' claim 11 or otherwise.

Moreover, and as has previously been indicated, the "instrument" recited in applicants' claim 11 has "an active part at a first end, and a handle at a second end of the instrument opposite to the first end" and "the handle of the instrument includes a first rotary drive which, when mounted in the housing, is capable of meshing directly with a second rotary drive associated with the body of the head... wherein the first rotary drive is capable of retractable axial retention in the housing, independently of the second rotary drive". As a consequence, neither the bearing support 22 provided in the upper surface 33 of the part 38, nor the unnumbered opening of the tool holding chuck 21 associated with the threaded bearing member 23, can serve as an opening for the insertion of applicants' instrument, as claimed, into the housing which is recited in applicants' claim 11.

As a consequence, the bottom of the bore 24 of the dental tool holder disclosed by Chayes et al. has an opening, i.e., the unnumbered opening of the tool holding chuck 21 which is associated with the threaded bearing member 23. However, none of the structures of the latching device 30 project across this opening. Upper portions of the bore 24 of the dental tool holder

disclosed by Chayes et al. (i.e., the part 38) incorporate a latching device 30. However, there is no opening in the part 38 for insertion of the tool into the bore 24. Consequently, there is no disclosure in Chayes et al. of a latching device which extends across an opening provided for insertion of the tool into the bore of the head, in accordance with applicants' claim 11, and contrary to the position taken at the bottom of page 4 of the Office Action of June 12, 2009.

Amendments have been made to claim 11, and claim 24 has been newly presented, to further define the previously recited "opening for insertion of the instrument into the housing" and to better correlate such structure to the original disclosure provided in the English translation of the French text specification submitted when steps were taken to enter the national stage of PCT/FR2003/003091, from which the current U.S. Patent Application is derived. Claim 15 has further been amended to provide proper antecedent basis for the subject matter which is recited, and claim 25 has been newly presented to recite the "automatic" operations of the apparatus of the present invention which are described, for example, from line 6 to line 12 of page 7 of the original specification for this Patent Application. Claims 26 to 36 have also been newly presented to additionally recite a combination of "a head for use with a handpiece of a contra-angle, and a dental instrument coupled with the head". In view of the foregoing discussion, it is respectfully submitted

that the patentability of such claims is in no way diminished by the disclosure of Chayes et al.

Claims 11 and 26 further recite "a ring coupled with the retention member and movable relative to the body of the head, against a restoring spring, wherein the ring is mounted concentrically on the body of the head". The dental tool holder disclosed by Chayes et al. does not incorporate any corresponding structures, which appears to have been acknowledged in the Office Action of June 12, 2009, noting lines 1 to 3 of page 5. However, it is then indicated that such structures are considered to be "an obvious matter of design choice", followed by a citation of the patent to Lustig in proposed combination with Chayes et al. as a disclosure of such structures.

Firstly, it is submitted that the disclosure of Lustig is not properly combined with the disclosure of Chayes et al. for purposes of rejecting applicants' claims. Noting lines 12 to 15 of column 2 of Lustig, it is indicated that "[t]he chamber for a dental tool has at one end an access opening for receiving a dental tool in the chamber, and at the other end a smaller opening for passing and supporting a dental tool shaft". Noting line 67 of column 3 through line 1 of column 4 of Lustig, it is further indicated that "[t]he tool 34 can then be removed from or inserted into the tool chamber, as is shown in FIG. 6". However, as is shown in Fig. 6 of Lustig, and also in Fig. 2, the disclosed tool is inserted into (and removed from) the tool chamber from

the top of the disclosed apparatus, and it is apparent that the tool cannot be inserted into or removed from the tool chamber from the bottom of the apparatus, as is the tool of Chayes et al. Consequently, it is submitted that the person of ordinary skill in the art at the time the present invention was made would not have considered combining Lustig's top-loading structures with the bottom-loading structures of Chayes et al.

Secondly, even if it is deemed to be appropriate to combine the disclosures of Chayes et al. and Lustig, applicants' recited structures would, nevertheless, not result from such a proposed combination. The second paragraph on page 5 of the Office Action of June 12, 2009, refers to a "latch structure 46 coupled with the retention member... and movable relative to the body of the head". However, noting lines 40 and 41 of column 3 of Lustig, the "latch structure 46" referred to in the Office Action is, in fact, a "finger-latch 46, 47 of known form" and, noting Figs. 1 and 3, operation of the disclosed finger-latch is essentially that of a push-button operating against the biasing forces of a leaf spring (unnumbered, but coincidentally pointed to in Fig. 3 by the reference number 10). It is submitted that Lustig's disclosure of a spring-biased finger-latch would not have constituted a disclosure to the person of ordinary skill in the art at the time the present invention was made of "a ring coupled with the retention member and movable relative to the body of the head, against a restoring spring, wherein the ring

is mounted concentrically on the body of the head", in accordance with applicants' claims 11 and 26.

It is, therefore, respectfully submitted that Lustig's disclosure is not properly combined with the disclosure of Chayes et al. for purposes of rejecting applicants' claims, and that even if the person of ordinary skill in the art at the time the present invention was made would have considered combining the disclosures of Chayes et al. and Lustig, applicants' claims 11 and 26 would not have been disclosed by such a combination. As a consequence of this, all that remains is the stated position that such structures are considered to be "an obvious matter of design choice", which is respectfully traversed. Pursuant to Section 2144.03 of the Manual of Patent Examining Procedure, the citation of a supporting reference is respectfully requested in the event that a rejection of applicants' claims 11 and 26 is maintained.


Further patentable distinctions recited in various dependent claims pending in this Patent Application were discussed in the Reply filed on October 3, 2008, and in the Amendment filed on April 23, 2009. This discussion is incorporated by reference as if fully set forth in this Reply and, as a consequence, need not be restated herein. Nevertheless, full reconsideration of applicants' dependent claims, including a consideration of all of the elements recited in such claims (in view of the foregoing legal

precedent) is respectfully requested.

It is, therefore, respectfully submitted that the pending claims of this Patent Application are not appropriately rejected under 35 U.S.C. §103(a) as being unpatentable over the combinations of Chayes et al., Lustig and Euvrard which have been proposed in the Office Action of June 12, 2009, and accordingly, that this Patent Application is in condition for allowance.

Corresponding action is earnestly solicited.

Respectfully submitted,


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